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PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
AND
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant : David Allison Bennett, et al.
Application No. : 09/685,078
Filed : October 6, 2000
Title : APPARATUS, SYSTEMS AND METHODS FOR ONLINE,
MULTI-CARRIER, MULTI-SERVICE PARCEL SHIPPING
MANAGEMENT FEATURING NOTIFICATION SERVICE
OPTION COMPARISON FOR MULTIPLE CARRIERS
Technology
Center : 3600
Grp./Div. : 3629
Examiner : Jamiesue A. Plucinski
Docket No. : PSTM0010/MRK/STM

APPELLANT'S REPLY BRIEF TRANSMITTAL LETTER

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

140 S. Lake Ave., Suite 312
Pasadena, CA 91101-4710
December 16, 2008

Commissioner:

Enclosed are the following:


1. Appellant's Reply Brief (23 pages); and
2. Return post card.

It is respectfully submitted that the enclosed Appellant's Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of December 16, 2008, which is the last day of the two month period following the October 16, 2008 date of the Examiner's Answer.

Even so, the Commissioner is hereby authorized, pursuant to 37 CFR 1.136(a)(3), to treat any concurrent or future reply or correspondence for the above-identified application, requiring a petition for an extension of time for its timely submission, as incorporating a constructive petition for extension of time for the appropriate length of time. The Commissioner is hereby authorized to charge any fees under 37 CFR 1.16 and 1.17, including any required extension fees, which may be required during the **pendency** of this application, to Deposit Account No. 501574.

Please show our docket number with any charge or credit to our Deposit Account. **A**
copy of this letter is enclosed.

Respectfully submitted,
KHORSANDI PATENT LAW GROUP, ALC

By  12/16/2008
Marilyn R. Khorsandi
Reg. No. 45,744
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MRK/aa
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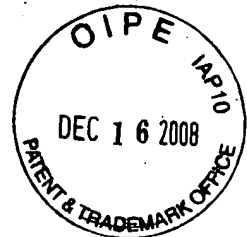
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Respectfully submitted,
KHORSANDI PATENT LAW GROUP, ALC

By Marilyn R. Khorsandi 12/16/2008
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APPLICANTS' REPLY BRIEF

This is a Reply to the Examiner's Answer, dated October 16, 2008, regarding the pending Appeal of the rejection of Claims 1-6, 28-33, 49-52, and 58 in the case of the above-identified application.

An Oral Hearing is not requested.

It is respectfully submitted that this Reply Brief is timely filed because it is filed in accordance with 37 C.F.R. §41.41(a)(1) prior to the expiration of December 16, 2008, which is the last day of the two month period following the October 16, 2008 date of the Examiner's Answer.

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Issue 1 Reply Argument Sub-Topic (a): The Statements by Both the Office Action and the Examiner's Answer That Nicholls Fails to Disclose Identifying or Determining Whether a Carrier Would Provide a Specific Service Exemplify the Problem Faced by a User as Explained by the Specification of the Present Application Regarding Comparing Different Rules by Different Carriers.

It is respectfully asserted that various exemplary embodiments of the limitations claimed by the subject Claims would provide a user with a comparison across carriers of an identification of carriers that would provide a particular delivery notification option requested by the user. It is respectfully asserted that such a comparison is not disclosed, anticipated, taught or suggested by the references of record, even when those references are considered in combination. Further, it is respectfully asserted that such a comparison would be helpful in assisting a user in making a selection of a carrier as compared to one exemplary problem explained by the Specification of the present application, namely, that:

One of the problems in dealing with standalone Carrier systems is that, if the Shipper wants electronic mail ("e-mail") notification that a particular parcel has been delivered, the Shipper must attempt to apply each Carrier's rules for providing a Shipper with electronic mail notification that a particular parcel has been delivered. *Each Carrier's electronic mail delivery notification pricing rules must be separately applied by the Shipper to shipment of a particular parcel to determine whether or not the particular Carrier offers electronic mail delivery notification and if so, the price for the service.*

Specification, p. 2, lines 19-25 (emphasis added).

The Examiner's Answer argues that "Nicholls discloses calculating rates for a package ..." and further states that the rates "... include special services (which the examiner considers to be a form of a delivery parameter)" Examiner's Answer,

Topic No. (9).10, p. 8. However, the Office Action and the Examiner's Answer both state that "Nicholls ... fails to disclose determining whether a carrier would provide a specific service...." Office Action, Topic No. 6, p. 4; Examiner's Answer, Topic No. (9).6, p. 5.

It is respectfully asserted that above-outlined position asserted by the Office Action and the Examiner's Answer does no more than describe a problem similar to the above-described problem in the Specification regarding standalone carrier systems.

Issue 1 Reply Argument Sub-Topic (b): Nicholls and Kara, Even When Combined, Fail to Disclose Identifying or Determining Whether a Carrier Would Provide a Requested Special Service, Such As Delivery Notification, for Shipping a Particular Parcel.

It is respectfully asserted, for the reasons given and under the authorities cited below, that combining a reference such as Nicholls, that is asserted as by the Examiner's Answer, to disclose a calculation of shipping rates for a package that includes a charge for special services, with a reference such as Kara, that is silent regarding special services, does not disclose, anticipate, teach or suggest the claimed limitations for determining or identifying whether a carrier would provide a requested delivery notification service.

The Office Action and the Examiner's Answer both state that "Nicholls ... fails to disclose determining whether a carrier would provide a specific service...." Office Action, Topic No. 6, p. 4; Examiner's Answer, Topic No. (9).6, p. 5.

However, the Examiner's Answer argues that "Nicholls discloses calculating rates for a package ..." and further states that the rates "... include special services (which the examiner considers to be a form of a delivery parameter)" Examiner's Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), p. 8 (not citing any specific disclosure of Nicholls in support of the assertion, but citing FIG. 4A of Nicholls in rejection Topic No. (9).5, p. 4).

The Examiner's Answer then uses the above-described argument regarding the calculation of rates by Nicholls, to combine Nicholls with Kara and argue that "when using Nicholls, which calculates rates for a particular package with particular delivery

parameters including special services and is capable of calculating a rate for multiple carriers, and combining it with Kara, which calculates rates for a particular package with particular delivery parameters, and displays the parameters for carriers who have been determined to meet the requirements, then the combination of the references would teach determining/identifying carriers that would provide special services, such as proof of delivery (delivery notification) for shipping a particular parcel” Examiner’s Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), pgs. 8-9.

Because the Examiner’s Answer concluded that Nicholls as a whole does not disclose the claimed limitation of determining whether a carrier would provide a specific service (See, e.g., Examiner’s Answer, Topic No. (9).6, p. 5), the comments by the Examiner’s Answer regarding Nicholls disclosing calculating rates cannot logically be interpreted to assert that calculating rates is equivalent to determining whether a carrier would provide a specific service. Rather, the calculation of a shipping rate for a carrier that includes, or doesn’t include, a charge for special services would not indicate whether the carrier provides, or does not provide the service, but would only indicate whether or not the carrier charges extra, or does not charge extra, for providing the special service.

In view of the Examiner’s Answer conclusion that Nicholls as a whole does not disclose the claimed limitation of determining whether a carrier would provide a specific service (See, e.g., Examiner’s Answer, Topic No. (9).6, p. 5), it is respectfully asserted that the above-cited statement by the Examiner’s Answer seems to be asserting that Nicholls calculates rates for a particular package with particular delivery parameters such as special services, so that if the Nicholls calculation were combined with Kara, Kara would not display a rate for a carrier that did not include a charge for a requested special service.

However, even if it were assumed for the sake of argument only, that Kara would not display a carrier’s rate if the carrier did not charge an extra fee for a requested special service, it is respectfully asserted that the combination of Nicholls with Kara urged by the Examiner’s Answer would, at most, result in Kara not displaying a rate for a carrier, even if the carrier offered the requested special service, but simply did not charge an extra fee for doing so.

Moreover, for the reasons given below, it is respectfully asserted that the combination of Nicholls and Kara asserted by the Examiner's Answer relies on an incorrect assumption that Kara would not display a rate for a carrier if the carrier did not provide a special service that was requested by a user. It is respectfully asserted that that assumption is incorrect because Kara is, in fact, silent regarding a user's input of requests for special services and regarding any actions by Kara with respect to a calculated charge, or absence of a charge, for special services.

In rejecting the subject Claims, the Examiner's Answer argues that "Kara, in column 22, discloses displaying multiple rates for the one particular package, and discloses that only the rates which meet the desired parameters are displayed."

Examiner's Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), p. 8.

The Examiner's Answer reasons that because Kara "... displays the parameters for carriers who have been determined to meet the requirements, then the combination of [Kara and Nicholls] would teach determining/identifying carriers that would provide special services, such as proof of delivery (delivery notification) for shipping a particular parcel" Examiner's Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), p. 9.

Contrary to the assumption urged by the Examiner's Answer that Kara would not display a rate for a carrier if the carrier did not provide a special service that was requested by a user, it is respectfully asserted that Kara is silent regarding special services. In particular, it is respectfully asserted that Kara does not even disclose any facility for user input of an indication of any type of special service of the type claimed. Rather, Kara discloses input of only basic "shipping and/or delivery parameters" such as the "entered parameters" of "weight, class, zone." See Kara, col. 22, lines 13-38. It is respectfully asserted that such basic parcel specifications as weight, and such basic shipping parameters as class and zone, are distinguished from special services that may, or may not be provided by particular carriers.

It is respectfully asserted that the above-described incorrect extrapolation of the disclosure of Kara that improperly attributes to Kara a non-existent feature regarding special services, when, in fact, Kara is silent on that subject, is evidence that the rejection of the subject Claims improperly imports a perspective gleaned from the present application to impermissibly read a non-existing feature into the Kara reference

and the combination of that reference with the other cited references. Cf. In re Mahurkar Patent Litigation, 831 F. Supp. 1354, 1374-75, 28 U.S.P.Q.2d (BNA) 1801, 1817 (N.D. Ill. 1993), *aff'd*, 71 F.3d 1573, 37 U.S.P.Q.2d 1138 (Fed. Cir. 1995).

Issue 1 Reply Argument Sub-Topic (c): The Citation of Fisher by the Office Action and the Examiner's Answer is Inapposite Because Fisher Discloses a System that Composes and Sends an Email Notice Rather Than Identifying or Determining Whether a Carrier Would Provide a Specific Service Such as Delivery Notification.

For the reasons given further below, it is respectfully asserted that the citation by the Office Action and the Examiner's Answer of the Fisher reference, misconstrues the limitations of the subject Claims for identifying or determining whether a carrier would provide a specific service such as delivery notification, and is inapposite regarding the assertion by both the Office Action and the Examiner's Answer of obviousness of the subject Claims.

The Office Action and the Examiner's Answer concede that "Nicholls ... fails to disclose the specific delivery requirements includes an electronic mail delivery notification ..." (Office Action, Topic No. 5, p. 4; Examiner's Answer, Topic No. (9).5, p. 4), but assert that "Fisher discloses a method for supplying automatic status updates using e-mail (See abstract) ..." and assert that "[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to have the proof of delivery of Nicholls be the electronic notification system, as disclosed by Fisher" Office Action, Topic No. 5, p. 4; Examiner's Answer, Topic No. (9).5, p. 4. The Office Action and the Examiner's Answer further assert that the aforementioned combination "... would have been obvious ... in order to automatically send delivery status messages over email without the aid or need of a human customer service representative [citing Fisher, cols. 1 and 2]." Office Action, Topic No. 5, p. 4; Examiner's Answer, Topic No. (9).5, p. 4.

The Examiner's Answer defends the citation of Fisher, stating that "Fisher was used to show the use of e-mail notification of the status of the delivery." Examiner's Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), p. 9. The Examiner's Answer further defends the citation of Fisher, stating that "[t]he appellant has asserted that there is no

where in Fisher that teaches the use of delivery confirmation, but rather delivery status messages over e-mail.” Examiner’s Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), p. 9.

It is respectfully asserted that the above-outlined argument by the Examiner’s Answer regarding the Fisher reference, misstates the argument presented by the Appeal Brief and once again misconstrues the limitations of the subject Claims for identifying or determining whether a carrier would provide a specific service such as delivery notification.

As compared to the limitations of the subject Claims for identifying or determining whether a carrier would provide a specific service such as delivery or email notification, Fisher discloses a merchant system that tracks shipment status of a customer’s order sent by a particular merchant using a particular carrier to the respective ordering customer. Fisher, col. 2, lines 12 – 18. According to Fisher, the Fisher system interrogates the carrier’s system to determine the shipping status of the respective order (Fisher, col. 2, lines 12 – 18) and then composes and sends an email notice to the respective ordering customer regarding their respective order shipment status (Fisher, col. 2, lines 12 – 18).

It is respectfully asserted that there is no disclosure in Fisher of the Fisher carriers themselves providing any type of delivery notification and there is no disclosure in Fisher of the Fisher system identifying or determining which carriers would provide delivery notification as claimed in one way or another by the subject Claims.

Issue 1 Reply Argument Conclusion

In view of the above-described distinctions and the distinctions described in the Appeal Brief between the disclosures of the cited references on the one hand, and independent Claims 49-52, on the other hand, it is respectfully asserted, for the reasons given above and in the Appeal Brief, that none of the cited references, whether considered alone or in combination with any other reference of record, disclose, anticipate, teach or suggest all of the limitations of Claims 49-52 of the present application. It is therefore respectfully requested that the rejection of Claims 49-52 be reversed and that those Claims be allowed.

Issue 2 Reply Argument Regarding the Rejection of Independent Claims 1 and 58, and Dependent Claims 2-6, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Fisher, Kara and InterShipper and Regarding the Appeal Brief Argument That There is No Disclosure in Nicholls, Fisher, Kara or InterShipper of Determining/Identifying Carriers That Would Provide the Requested Type of Delivery Notification Service for Shipping a Particular Parcel.

With regard to the Appeal Brief Issue 2 Argument, the Examiner's Answer states that "[t]he appellant has simply repeated the arguments for Issue 1." Examiner's Answer, Topic No. (10)(Re Appeal Brief Issue 2), pgs. 10-11. The Examiner's Answer then refers to the arguments made in the Examiner's Answer with respect to Issue 1. Examiner's Answer, Topic No. (10)(Re Appeal Brief Issue 2), p. 11.

The same references, namely, Nicholls, Kara, InterShipper and Fisher, were cited as grounds for rejecting independent Claims 1 and 58, as were cited as grounds for rejecting independent Claims 49-52. Appellants have chosen, as is their right to do under 37 CFR Sec. 41.37(c)(1)(vii), to separately argue Claims 1 and 58. Appellants incorporate by reference the arguments made under the Issue 1 Reply Argument above herein as if fully stated here, except that where the arguments made under the Issue 1 Reply Argument refer to special services, or delivery notification services or options, as claimed in one way or another by independent Claims 49-52, Claims 1 and 58 are directed to determining whether, or identifying whether, a respective carrier would provide electronic mail delivery notification.

Even though the Examiner's Answer makes the above-quoted statement summarily referring to its arguments regarding Appellant's Issue 1, with respect to Appellant's Issue 2 Appeal Brief, the Examiner's Answer nevertheless additionally states that "all the references used request information for a particular package and do not disclose a general request, as stated by appellant." Examiner's Answer, Topic No. (10)(Re Appeal Brief Issue 2), p. 10.

Because the Examiner's Answer chose to explicitly state the above-cited argument with regard to Appellant's Issue 2, Appellants respectfully reply as follows:

It is respectfully asserted, for the reasons given and under the authorities previously cited above, that combining a reference such as Nicholls, that is asserted as by the Examiner's Answer, to disclose a calculation of shipping rates for a package that includes a charge for special services, such as electronic mail delivery notification, with a reference such as Kara, that is silent regarding special services, does not disclose, anticipate, teach or suggest the claimed limitations for determining or identifying whether a carrier would provide a particular special service, such as electronic mail delivery notification, with respect to a particular parcel.

As previously mentioned above, the Office Action and the Examiner's Answer both state that "Nicholls ... fails to disclose determining whether a carrier would provide a specific service...." Office Action, Topic No. 6, p. 4; Examiner's Answer, Topic No. (9).6, p. 5.

However, the Examiner's Answer argues that "Nicholls discloses calculating rates for a package ..." and further states that the rates "... include special services (which the examiner considers to be a form of a delivery parameter)" Examiner's Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), p. 8 (not citing any specific disclosure of Nicholls in support of the assertion, but citing FIG. 4A of Nicholls in rejection Topic No. (9).5, p. 4).

The Examiner's Answer then uses the above-described argument regarding the calculation of rates by Nicholls, to combine Nicholls with Kara and argue that "when using Nicholls, which calculates rates for a particular package with particular delivery parameters including special services and is capable of calculating a rate for multiple carriers, and combining it with Kara, which calculates rates for a particular package with particular delivery parameters, and displays the parameters for carriers who have been determined to meet the requirements, then the combination of the references would teach determining/identifying carriers that would provide special services, such as proof of delivery (delivery notification) for shipping a particular parcel" Examiner's Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), pgs. 8-9.

As previously mentioned above, because the Examiner's Answer concluded that Nicholls as a whole does not disclose the claimed limitation of determining whether a carrier would provide a specific service (See, e.g., Examiner's Answer, Topic No. (9).6,

p. 5), the comments by the Examiner's Answer regarding Nicholls disclosing calculating rates cannot logically be interpreted to mean calculating rates is equivalent to determining whether a carrier would provide a specific service, such as electronic mail delivery notification. Rather, as previously mentioned above, the calculation of a shipping rate for a carrier that includes, or doesn't include, a charge for special services would not indicate whether the carrier provides, or does not provide the service, but would only indicate whether or not the carrier charges extra, or does not charge extra, for providing the special service, such as electronic mail delivery notification.

Nonetheless, for the reasons previously given above, it is respectfully asserted that the above-cited statement by the Examiner's Answer seems to be asserting that Nicholls calculates rates for a particular package with particular delivery parameters such as special services, so that if the Nicholls calculation were combined with Kara, Kara would not display a rate for a carrier that did not include a charge for a requested special service, such as electronic mail delivery notification.

However, as previously mentioned above, even if it were assumed for the sake of argument only, that Kara would not display a carrier's rate if the carrier did not charge an extra fee for a requested special service, it is respectfully asserted that the combination of Nicholls with Kara urged by the Examiner's Answer would, at most, result in Kara not displaying a rate for a carrier, even if the carrier offered the requested special service, such as electronic mail delivery notification, but simply did not charge an extra fee for doing so.

Moreover, for the reasons previously given above, it is respectfully asserted that the combination of Nicholls and Kara asserted by the Examiner's Answer relies on an incorrect assumption that Kara would not display a rate for a carrier if the carrier did not provide a special service that was requested by a user, where Kara is, in fact, silent regarding a user's input of requests for special services and regarding any actions by Kara with respect to a calculated charge, or absence of a charge, for special services, such as electronic mail delivery notification.

In view of the above-described distinctions between the disclosures of the cited references on the one hand, and independent Claims 1 and 58, and their respective dependent Claims 2-6, on the other hand, it is respectfully asserted, for the reasons

given above and for the reasons and under the authorities given in the Appeal Brief, that none of the cited references, whether considered alone or in combination with any other reference of record, do not anticipate, disclose, teach or suggest all of the limitations of Claims 1 and 58, and therefore dependent Claims 2-6, of the present application. It is therefore respectfully requested that the rejection of Claims 1 and 58, and therefore dependent Claims 2-6, be reversed and that those Claims be allowed.

Issue 3 Reply Argument Regarding the Rejection of Independent Claims 1, 49, 50, 51, 52, and 58, and Dependent Claims 2-6, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Fisher, Kara and InterShipper and Regarding the Appeal Brief Argument That There is No Disclosure in Nicholls, Fisher, Kara and InterShipper for Displaying a Simultaneous Identification of Shipping Charges for Shipping the Particular Parcel for Each Delivery Service Offered by Each Respective Carrier of the Plurality of Carriers That Would Provide the Requested Delivery Notification Service For the Particular Parcel.

The Examiner's Answer concedes that "Kara discloses a simultaneous display for multiple carriers, but for one service at a time." Examiner's Answer, Topic No. (10)(Re Appeal Brief Issue 3), p. 11; see also, e.g., Office Action, Topic No. (9).7, p. 5 (conceding that "Nicholls, Fisher and Kara ... fails to disclose the simultaneous display of the rates for each carrier for each service").

In view of the above-stated limitation of Kara to show a display for only one service at a time, the Examiner's Answer subsequently relies on InterShipper "... to disclose simultaneous display of rates for each service of each carrier" Examiner's Answer, Topic No. (10)(Re Appeal Brief Issue 3), p. 11.

In the Appeal Brief, Appellants respectfully asserted, under the holding of Reading and Bates, that although the cited InterShipper reference may qualify as a prior art reference under Section 103, it may only be used as a prior art reference "... for what is in fact disclosed in it." See Reading and Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 652 (Fed. Cir. 1984).

In particular, in the Appeal Brief, Appellants respectfully asserted that, contrary to the inferences apparently asserted by the Office Action, the InterShipper reference never states that the InterShipper service would display its results simultaneously.

Rather, the InterShipper reference states only that “[t]he free service will return every method possible that you can use to ship your package” InterShipper, p. 1, ¶2. It does not say that such returned “every method possible” will be simultaneously displayed.

Further, in the Appeal Brief, Appellants respectfully asserted that the InterShipper reference never states that the InterShipper service would include shipping charges for each delivery service offered by the “major shippers.” To the contrary, the InterShipper reference specifically states that “Internet users can now get shipping rates from all major shippers ...” (InterShipper, p. 1, ¶2.), not by each delivery service offered by “all the major shippers” as suggested in the Office Action.

The Examiner’s Answer responds to the above-outlined argument, stating that “... appellant is arguing that ‘every method’ means each delivery service offered by each carrier.” Examiner’s Answer, Topic No. (10)(*Re Appeal Brief Issue 3*), p. 12.

The above-quoted statement is a misstatement of Appellants’ Appeal Brief Argument. On the contrary, Appellants asserted in the Appeal Brief, and do assert, that the statement by InterShipper that “every method” is displayed does not state that “every method” means every delivery service.

The Examiner’s Answer responds, saying that “... even if the term ‘every method’ is not completely clear that it means each delivery service for each carrier[,] InterShipper is combined with Kara. Kara discloses a display of rates for each carrier for a particular delivery service, the examiner considers a method of delivering a package to include a type of service in which the method would use to delivery [sic] the package.” Examiner’s Answer, Topic No. (10)(*Re Appeal Brief Issue 3*), p. 12.

In view of the apparent concession by the Examiner’s Answer that InterShipper’s description of “every method” does not “completely clea[rl]y” disclose every delivery service, it is therefore respectfully asserted that combining InterShipper with Kara (which the Examiner has already conceded only displays “... for one service at a time.” Examiner’s Answer, Topic No. (10)(*Re Appeal Brief Issue 3*), p. 11; see also, e.g., Office Action, Topic No. (9).7, p. 5 (conceding that “Nicholls, Fisher and Kara ... fails to disclose the simultaneous display of the rates for each carrier for each service”) does not serve as sufficient grounds on which to conclude obviousness of the limitations

claimed in one way or another by Independent Claims 1, 49, 50, 51, 52, and 58, and Dependent Claims 2-6 for displaying a simultaneous identification of shipping charges for shipping a particular parcel for each delivery service offered by each respective carrier of a plurality of carriers that would provide a requested delivery notification service.

Moreover, even assuming for the sake of argument only, that "every method" described by InterShipper would be understood to mean every delivery method, InterShipper simply does not state that "every method" would be simultaneously displayed.

Accordingly, it is respectfully asserted that the combinations of the limitations recited by Independent Claims 1, 49, 50, 51, 52, and 58, and Dependent Claims 2-6, are therefore not disclosed, anticipated, taught or suggested by InterShipper.

Moreover, because the Office Action and the Examiner's Answer relied on InterShipper to provide the conceded missing link of a simultaneous display absent from the Nicholls, Fisher and Kara references, it is therefore respectfully asserted that the combinations of limitations recited by Independent Claims 1, 49, 50, 51, 52, and 58, and Dependent Claims 2-6, are therefore not disclosed, anticipated, taught or suggested by, and are non-obvious in view of, the combination of the Nicholls, Fisher, Kara and InterShipper references.

In view of the above-given reasons and authorities, and for the reasons given and authorities cited in the Appeal Brief, it is respectfully asserted that the combination of limitations claimed by Independent Claims 1, 49, 50, 51, 52, and 58, and Dependent Claims 2-6, are non-obvious over the references of record. It is therefore respectfully requested that the rejections of Claims 1-6, 49-52 and 58 be reversed and that those Claims be allowed.

Issue 4 Reply Argument Regarding the Rejection of Independent Claim 28, and Dependent Claims 29-33, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Pauly, Kara and InterShipper and Regarding the Appeal Brief Argument That There is No Disclosure in Nicholls, Pauly, Kara or InterShipper of Determining Carriers That Would Provide Verbal Delivery Notification for Shipping a Particular Parcel.

Issue 4 Reply Argument Sub-Topic (a): Nicholls and Kara, Even When Combined, Fail to Disclose Identifying or Determining Whether a Carrier Would Provide a Requested Special Service, Such As Verbal Delivery Notification, for Shipping a Particular Parcel.

It is respectfully asserted for the reasons given in the Appeal Brief and for the reasons given below, that none of the cited references, including the combination of Nicholls and Kara, as asserted by the Examiner's Answer, disclose that some carriers may provide a particular special service, such as verbal delivery notification, and that some carriers may not, with respect to a particular parcel. Moreover, it is respectfully asserted that none of the cited references, including the combination of Nicholls and Kara, as asserted by the Examiner's Answer, disclose, anticipate, teach or suggest identifying or determining whether or not a carrier would provide a particular special service, such as verbal delivery notification, with respect to a particular parcel.

It is respectfully asserted, for the reasons given and under the authorities previously cited above, that combining a reference such as Nicholls, that is asserted as by the Examiner's Answer, to disclose a calculation of shipping rates for a package that includes a charge for special services, with a reference such as Kara, that is silent regarding special services, does not disclose, anticipate, teach or suggest the claimed limitations for determining or identifying whether a carrier would provide a particular special service, such as verbal delivery notification, with respect to a particular parcel.

As previously mentioned above, the Office Action and the Examiner's Answer both state that "Nicholls ... fails to disclose determining whether a carrier would provide a specific service...." Office Action, Topic No. 6, p. 4; Examiner's Answer, Topic No. (9).6, p. 5.

However, the Examiner's Answer argues that "Nicholls discloses calculating rates for a package ..." and further states that the rates "... include special services

(which the examiner considers to be a form of a delivery parameter)” Examiner’s Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), p. 8 (not citing any specific disclosure of Nicholls in support of the assertion, but citing FIG. 4A of Nicholls in rejection Topic No. (9).5, p. 4).

The Examiner’s Answer then uses the above-described argument regarding the calculation of rates by Nicholls, to combine Nicholls with Kara and argue that “when using Nicholls, which calculates rates for a particular package with particular delivery parameters including special services and is capable of calculating a rate for multiple carriers, and combining it with Kara, which calculates rates for a particular package with particular delivery parameters, and displays the parameters for carriers who have been determined to meet the requirements, then the combination of the references would teach determining/identifying carriers that would provide special services, such as proof of delivery (delivery notification) for shipping a particular parcel” Examiner’s Answer, Topic No. (10)(*Re Appeal Brief Issue 1*), pgs. 8-9.

As previously mentioned above, because the Examiner’s Answer concluded that Nicholls as a whole does not disclose the claimed limitation of determining whether a carrier would provide a specific service (See, e.g., Examiner’s Answer, Topic No. (9).6, p. 5), the comments by the Examiner’s Answer regarding Nicholls disclosing calculating rates cannot logically be interpreted to mean calculating rates is equivalent to determining whether a carrier would provide a specific service, such as verbal delivery notification. Rather, as previously mentioned above, the calculation of a shipping rate for a carrier that includes, or doesn’t include, a charge for special services would not indicate whether the carrier provides, or does not provide the service, but would only indicate whether or not the carrier charges extra, or does not charge extra, for providing the special service, such as verbal delivery notification.

Nonetheless, for the reasons previously given above, it is respectfully asserted that the above-cited statement by the Examiner’s Answer seems to be asserting that Nicholls calculates rates for a particular package with particular delivery parameters such as special services, so that if the Nicholls calculation were combined with Kara, Kara would not display a rate for a carrier that did not include a charge for a requested special service, such as verbal delivery notification.

However, as previously mentioned above, even if it were assumed for the sake of argument only, that Kara would not display a carrier's rate if the carrier did not charge an extra fee for a requested special service, it is respectfully asserted that the combination of Nicholls with Kara urged by the Examiner's Answer would, at most, result in Kara not displaying a rate for a carrier, even if the carrier offered the requested special service, such as verbal delivery notification, but simply did not charge an extra fee for doing so.

Moreover, for the reasons previously given above, it is respectfully asserted that the combination of Nicholls and Kara asserted by the Examiner's Answer relies on an incorrect assumption that Kara would not display a rate for a carrier if the carrier did not provide a special service that was requested by a user, where Kara is, in fact, silent regarding a user's input of requests for special services and regarding any actions by Kara with respect to a calculated charge, or absence of a charge, for special services, such as verbal delivery notification.

Because, for the reasons given above, the combination of Nicholls and Kara fails to disclose identifying or determining whether a carrier would provide a requested special service, such as verbal delivery notification, for shipping a particular parcel, as claimed in one way or another by the subject Claims, namely, independent Claim 28, and dependent Claims 29-33, it is therefore respectfully requested that the rejection of the subject Claims, namely, independent Claim 28, and dependent Claims 29-33 be reversed and that those Claims be allowed.

Issue 4 Reply Argument Sub-Topic (b): The Citation of Pauly by the Office Action and the Examiner's Answer is Inapposite Because Pauly Discloses a System that Composes and Sends an Email Notice Rather Than Identifying or Determining Whether a Carrier Would Provide a Specific Service Such as Delivery Notification.

For the reasons given further below, it is respectfully asserted that the citation by the Office Action and the Examiner's Answer of the Fisher reference, misconstrues the limitations of the subject Claims for identifying or determining whether a carrier would provide a specific service such as delivery notification, and is inapposite regarding the assertion by both the Office Action and the Examiner's Answer of obviousness of the

subject Claims.

The Office Action and the Examiner's Answer concede that "Nicholls ... fails to specifically disclose the proof of delivery is a verbal delivery notification ..." (Office Action, Topic No. 13, p. 6; Examiner's Answer, Topic No. (9).13, p. 6), but assert that "Pauley [sic] discloses the use of customer service representatives which provide verbal communication of delivery status" Office Action, Topic No. 13, p. 6; Examiner's Answer, Topic No. (9).13, p. 6. The Office Action and the Examiner's Answer further assert that "[i]t would have been obvious ... to have the proof of delivery of Nicholls be the notification by the costumer [sic] service representative, as disclosed by Pauley [sic]" Office Action, Topic No. 13, p. 6; Examiner's Answer, Topic No. (9).13, p. 6. The Office Action and the Examiner's Answer further assert that the aforementioned combination "... would have been obvious ... in order to allow users to obtain delivery information without the use of a computer [citing Pauly, cols. 2 and 4]." Office Action, Topic No. 13, p. 6; Examiner's Answer, Topic No. (9).13, p. 6.

The Examiner's Answer defends the citation of Pauly, stating that "Paulyr [sic] was used to show the use of verbal notification of the status of the delivery." Examiner's Answer, Topic No. (10)(*Re Appeal Brief Issue 4*), p. 14.

It is respectfully asserted that the above-outlined argument by the Examiner's Answer regarding the Pauly reference, misstates the argument presented by the Appeal Brief and once again misconstrues the limitations of the subject Claims for identifying or determining whether a carrier would provide a verbal delivery notification service with respect to delivery of a particular parcel.

As compared to the limitations of the subject Claims for identifying or determining whether a carrier would provide a verbal delivery notification service with respect to delivery of a particular parcel, Pauly is directed to a central ordering/inventory system for ongoing fulfillment of disposable contact lens prescriptions. See Pauly, Abstract. Pauly discloses shipping from the centralized inventory to the respective eye care professionals. See, e.g., Pauly, col. 3, lines 1-10.

As compared to the limitations of e.g., Claim 28 "...for each respective carrier of a plurality of carriers, determin[ing] whether the respective carrier would provide verbal delivery notification for shipping the particular parcel according to the request ...," the

Pauly system is "... [p]rogram[med] to allow customer service representatives to view orders already generated and learn the status of these orders, picked, shipped, etc. The representatives will also be able to confirm prescriptions as well as ship-to addresses."

Pauly, col. 9, lines 34-38.

As compared to the above-cited assertions by the Office Action and the Examiner's Answer, it is respectfully submitted that the limitations claimed by Claims 28-33 are not directed to supplying, or in any way providing, verbal communication of delivery status. In particular, as compared to the assertion by the Office Action that Pauly "... discloses the use of customer service representatives which provide verbal communication of delivery status...", Claim 28, for example, is directed to determining which carriers provide the requested verbal delivery notification for shipping a particular parcel, and to providing a simultaneous display of *shipping charges* for various carriers and various delivery services that would provide the requested verbal delivery notification for shipping a particular parcel.

Further still, as compared to the assertion by the Office Action that it would have been obvious to make the asserted combination "...in order to allow users to obtain delivery information without the use of a computer ...," it is respectfully asserted that there is no disclosure in Pauly of *carriers themselves* providing any type of delivery notification. Yet further, it is respectfully asserted that there is no disclosure in Pauly of any monetary distinction or service level distinction, or of any report or display of any monetary or service level distinction, between shipping charges or service levels provided by one carrier or another for providing one type or another of delivery notification.

In view of the above-described distinctions and the distinctions described in the Appeal Brief between the disclosures of the references of record on the one hand, and Claims 28-33, on the other hand, it is respectfully asserted, for the reasons given and under the authorities cited above, that the references of record, whether considered alone or in combination, do not anticipate, disclose, teach or suggest all of the limitations of Claims 28-33 of the present application. It is therefore respectfully requested that the rejection of Claims 28-33 be reversed and that those Claims be allowed.

Issue 5 Reply Argument Regarding the Rejection of Independent Claim 28, and Dependent Claims 29-33, Under 35 U.S.C. §103(a) as Unpatentable over Nicholls in View of Pauly, Kara and InterShipper and Regarding the Appeal Brief Argument That There is No Disclosure in Nicholls, Pauly, Kara and InterShipper for Displaying a Simultaneous Identification of Shipping Charges for Shipping the Particular Parcel for Each Delivery Service Offered by Each Respective Carrier of the Plurality of Carriers That Would Provide Verbal Delivery Notification Service.

The Examiner's Answer concedes that "Kara discloses a simultaneous display for multiple carriers, but for one service at a time." Examiner's Answer, Topic No. (10)(Re Appeal Brief Issue 5), p. 16; see also, e.g., Office Action, Topic No. (9).15, p. 7 (conceding that "Nicholls, Fisher and Kara ... fails to disclose the simultaneous display of the rates for each carrier for each service").

In view of the above-stated limitation of Kara to show a display for only one service at a time, the Examiner's Answer subsequently relies on InterShipper "... to disclose simultaneous display of rates for each service of each carrier" Examiner's Answer, Topic No. (10)(Re Appeal Brief Issue 5), p. 16.

In the Appeal Brief, Appellants respectfully asserted, under the holding of Reading and Bates, that although the cited InterShipper reference may qualify as a prior art reference under Section 103, it may only be used as a prior art reference "... for what is in fact disclosed in it." See Reading and Bates Construction Co. v. Baker Energy Resources Corp., 748 F.2d 645, 652 (Fed. Cir. 1984).

In particular, in the Appeal Brief, Appellants respectfully asserted that, contrary to the inferences apparently asserted by the Office Action, the InterShipper reference never states that the InterShipper service would display its results simultaneously. Rather, the InterShipper reference states only that "[t]he free service will return every method possible that you can use to ship your package" InterShipper, p. 1, ¶2. It does not say that such returned "every method possible" will be simultaneously displayed.

Further, in the Appeal Brief, Appellants respectfully asserted that the InterShipper reference never states that the InterShipper service would include shipping charges for each delivery service offered by the "major shippers." To the contrary, the InterShipper reference specifically states that "Internet users can now get shipping rates from all

major shippers ..." (*InterShipper*, p. 1, ¶2.), not by each delivery service offered by "all the major shippers" as suggested in the Office Action.

The Examiner's Answer responds to the above-outlined argument, stating that "... appellant is arguing that 'every method' means each delivery service offered by each carrier." *Examiner's Answer*, Topic No. (10)(*Re Appeal Brief Issue 5*), p. 16.

The above-quoted statement is a misstatement of Appellants' Appeal Brief Argument. On the contrary, Appellants asserted in the Appeal Brief, and do assert, that the statement by *InterShipper* that "every method" is displayed does not state that "every method" means every delivery service.

The Examiner's Answer responds, saying that "... even if the term 'every method' is not completely clear that it means each delivery service for each carrier[,] *InterShipper* is combined with *Kara*. *Kara* discloses a display of rates for each carrier for a particular delivery service, the examiner considers a method of delivering a package to include a type of service in which the method would use to delivery [sic] the package." *Examiner's Answer*, Topic No. (10)(*Re Appeal Brief Issue 5*), p. 16.

In view of the apparent concession by the Examiner's Answer that *InterShipper's* description of "every method" does not "completely clea[rl]"y disclose every delivery service, it is therefore respectfully asserted that combining *InterShipper* with *Kara* (which the Examiner has already conceded only displays "... for one service at a time." *Examiner's Answer*, Topic No. (10)(*Re Appeal Brief Issue 5*), p. 16; see also, e.g., *Office Action*, Topic No. (9).15, p. 7 (conceding that "Nicholls, Fisher and *Kara* ... fails to disclose the simultaneous display of the rates for each carrier for each service") does not serve as sufficient grounds on which to conclude obviousness of the limitations claimed in one way or another by Independent Claim 28, and Dependent Claims 29-33 for displaying a simultaneous identification of shipping charges for shipping a particular parcel for each delivery service offered by each respective carrier of a plurality of carriers that would provide a verbal delivery notification service.

Moreover, even assuming for the sake of argument only, that "every method" described by *InterShipper* would be understood to mean every delivery method, *InterShipper* simply does not state that "every method" would be simultaneously displayed.

Accordingly, it is respectfully asserted that the combinations of the limitations recited by Independent Claim 28, and Dependent Claims 29-33, are therefore not disclosed, anticipated, taught or suggested by InterShipper.

Moreover, because the Office Action and the Examiner's Answer relied on InterShipper to provide the conceded missing link of a simultaneous display absent from the Nicholls, Fisher and Kara references, it is therefore respectfully asserted that the combinations of limitations recited by Independent Claim 28, and Dependent Claims 29-33, are therefore not disclosed, anticipated, taught or suggested by, and are non-obvious in view of, the combination of the Nicholls, Fisher, Kara and InterShipper references.

In view of the above-given reasons and authorities, and for the reasons given and authorities cited in the Appeal Brief, it is respectfully asserted that the combination of limitations claimed by Independent Claim 28, and Dependent Claims 29-33, are non-obvious over the references of record. It is therefore respectfully requested that the rejections of Claims 28-33 be reversed and that those Claims be allowed.

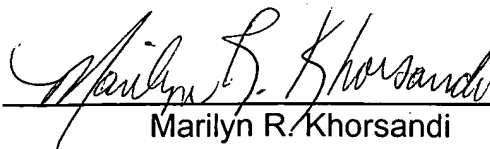
REPLY ARGUMENT CONCLUSION

For the above-given reasons and authorities, in view of the above-described distinctions between the disclosures of Nicholls, Fisher, Kara, Pauly, and InterShipper on the one hand, and independent Claims 1, 28, 49-52 and 58, and therefore the Claims dependent on independent Claims 1, 28, 49-52 and 58, namely, dependent Claims 2-6 and 29-33, it is respectfully requested that the rejection of Claims 1-6, 28-33, 49-52 and 58 be reversed and that those Claims be allowed.

Respectfully submitted,

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